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Date: September 17, 2004

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• Comments:

Jennifer,  
Please let me know if you have any questions  
or concerns regarding the attached. Thank you,  
Paul

CONFIRMATION BY MAIL: ☐ NO ☒ YES

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|-------------------------------------------------------------------------------------|----------------------|------------------------|---------------|
| <b>TRANSMITTAL FORM</b><br>(to be used for all correspondence after initial filing) | Application Number   | 10/834/885             |               |
|                                                                                     | Filing Date          | August 6, 2003         |               |
|                                                                                     | First Named Inventor | Culp, Stephen A.       |               |
|                                                                                     | Art Unit             | 3634                   |               |
|                                                                                     | Examiner Name        | Novosad, Jennifer E.   |               |
| Total Number of Pages in This Submission                                            | 6                    | Attorney Docket Number | 07408_00/0101 |

| ENCLOSURES (Check all that apply)                                            |                                                                                                                   |                                                                                         |
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| <input type="checkbox"/> Response to Missing Parts/Incomplete Application    | <b>Remarks</b><br>Written Statement regarding telephone interview pursuant to 37 C.F.R. Section 1.33(b) (5 pages) |                                                                                         |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 |                                                                                                                   |                                                                                         |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT |                                   |
|--------------------------------------------|-----------------------------------|
| Firm or Individual name                    | Chambliss, Bahner & Stophel, P.C. |
| Signature                                  | <i>Paul S. Weidlich</i>           |
| Date                                       | September 17, 2004                |

| CERTIFICATE OF TRANSMISSION/MAILING                                                                                                                                                                                                                                                                           |                         |
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| Typed or printed name                                                                                                                                                                                                                                                                                         | Paul S. Weidlich        |
| Signature                                                                                                                                                                                                                                                                                                     | <i>Paul S. Weidlich</i> |
| Date                                                                                                                                                                                                                                                                                                          | September 17, 2004      |

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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SEP 17 2004

In Re: Application of Stephen A. Culp )  
For: Modular Construction System )  
Serial No.: 10/634,685 )  
Filed: 08/06/2003 )

Examiner: J. Novosad

Group Art Unit: 3634

**WRITTEN STATEMENT REGARDING**  
**TELEPHONE INTERVIEW**  
**PURSUANT TO 37 C.F.R. § 1.133(b)**

On Thursday, September 16, 2004, a telephone interview with Examiner Jennifer E. Novosad and counsel for the Applicant, Paul S. Weidlich, was conducted in connection with the above-captioned matter. During the course of the interview, counsel for the Applicant and Examiner Novosad agreed upon an amendment to claim 1 which, according to Examiner Novosad, appears to define over the applied prior art references. More particularly, counsel for the Applicant and Examiner Novosad agreed to amend claim 1 of the pending application to replace the functional language of the last clause of that claim with structural language that appears to define over both of the prior art references cited in the Office Action mailed on May 19, 2004, *i.e.*, U.S. Patent No. 2,854,724 of Wuorio ("Wuorio '724") and U.S. Patent No. 3,812,977 of Glassman ("Glassman '977"). In email correspondence dated September 17, 2004, counsel for Applicant and Examiner Novosad agreed to a minor revision of the proposed amendment of claim 1 discussed on September 16, 2004. Again, Examiner Novosad stated that the proposed amendment to claim 1 appears to define over the applied art.

The amended claim language of claim 1 which was agreed upon by counsel for the Applicant and Examiner Novosad is as follows:

(07408\_00/0101/00638350.DOC.)

~~wherein each of said plurality of structural members is adapted to be detachably connected slot-to-slot to each of the other of said plurality of structural members~~ each of said at least two slots along one of said lengthwise sides of one of said plurality of structural members is detachably and selectively connected slot-to-slot to one of all of said at least two slots along one of said lengthwise sides of each of the other of said plurality of structural members.

As noted above, according to Examiner Novosad, claim 1 of the pending patent application, as amended, appears to define over the applied art.

Prior to reaching the agreed upon amended claim language, counsel for the Applicant argued that the unique spaced relationship between (1) the distance from a widthwise side of a structural member to the center axis of the nearest slot along a lengthwise side, and (2) the distance from the center axis of each slot along the same lengthwise side of a structural member to the center axis of every other slot along such lengthwise side of the structural member is not an obvious matter of design choice as asserted in the Office Action mailed May 19, 2004. In support of this position, counsel for Applicant pointed to the Examiner's Statement of Reasons for Allowance in the parent patent application, which has now issued as U.S. Patent No. 6,615,999.

As counsel for the Applicant noted, the Examiner's Statement of Reasons for Allowance in the parent application states that "the distance between the . . . slot axes of each of the . . . member slots on each of the . . . members is a whole number multiple of the predetermined slot-to-side distance." The Examiner's Statement of Reasons for Allowance further states that "there is no teaching in the prior art to have the 'slot-to-slot' distance be a whole number multiple of the 'slot-to-side' distance and there is not motivation to provide any of the prior art references with

this feature since it is not an obvious design choice to have the slots and sides compared in such a way as called for in the claims . . . " (emphasis added).

Based upon the foregoing statements contained in the Examiner's Statement of Reasons for Allowance in the parent application, counsel for the Applicant argued that the rejections of claims 1-4 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Wuorio '724 should be withdrawn. Examiner Novosad suggested that the Examiner's Statement of Reasons for Allowance in the parent application may not have included all of the reasons for allowing the claims in the parent application. Counsel for the Applicant pointed out that notwithstanding any additional reasons for allowance of the claims in the parent application, if the unique spaced relationship defined in the parent application was not an obvious design choice in view of the prior art, then the same unique spaced relationship defined in the pending application should not be rejected as an obvious design choice based upon the same prior art references.

Counsel for the Applicant and Examiner Novosad did not pursue this issue further once the above amendment to claim 1 was agreed upon and Examiner Novosad stated that such amendment appears to define over the applied art, including Wuorio '724. More particularly, Wuorio '724 does not teach or suggest a system of modular construction wherein each of the slots of one structural member may be connected slot-to-slot with each of the slots of the other structural members. Indeed, Wuorio '724 describes a finitely-defined construction in which certain slots on certain structural members cannot be detachably connected slot-to-slot with certain slots on other structural members. For example, referring to Figure 8, structural member 40 cannot be moved from its illustrated position toward structural member 22 such that slot 48B is detachably connected slot-to-slot to slot 20C of structural member 22. Such a movement of structural member 40 would abrogate the utility of the claimed invention. Consequently, there is

no motivation or suggestion in Wuorio '724 to provide a plurality of structural members each having a plurality of slots that may be detachably connected slot-to-slot to any other slots on any other structural member.

By contrast, the Applicant's claimed invention, as defined by the amended claim language described above, requires that each of the slots along the lengthwise side of a structural member may be connected to each of the slots along the lengthwise side of any other structural member. Given this structural distinction, counsel for the Applicant and Examiner Novosad agreed that amended claim 1 appears to define over Wuorio '724.

As to the other prior art reference cited in the Office Action mailed on May 19, 2004, *i.e.* Glassman '977, counsel for the Applicant and Examiner Novosad agreed that the above-described amendment to claim 1 appears to define over the reference. More particularly, counsel for the Applicant and Examiner Novosad agreed that Glassman does not teach or suggest the limitation recited in the above-described amendment to claim 1. Indeed, the construction disclosed by Glassman '977 includes structural members that are fixedly connected to each other such that a certain slot(s) in one structural member cannot possibly be connected to a certain slot(s) in another structural member. For example, slot 24 of structural member 10 cannot possibly be detachably connected slot-to-slot to slot 20 or slot 22 of structural member 14. *See* Fig. 2. Further, slot 22' of structural member 10 cannot possibly be detachably connected slot-to-slot to slot 24' or slot 20' of structural member 14'. *See* Fig. 3.

By contrast, the Applicant's claimed invention, as defined by the amended claim language described above, requires that any of the slots along the lengthwise side of a structural member may be connected to each of the slots along the lengthwise side of any other structural

member. Given this structural distinction, counsel for Applicant and Examiner Novosad agreed that the proposed amendment to claim 1 appears to define over Glassman '724.

Based upon the foregoing, Examiner Novosad recommended that claim 1 of the pending patent application be amended as described above. Examiner Novosad further recommended that counsel for Applicant present any remarks in support of Applicant's position and present an additional drawing to address the objections to the drawings noted in the May 19, 2004 Office Action. Finally, Examiner Novosad recommended that counsel for Applicant contact her by telephone when the Applicant's Amendment/Response to Office Action is being mailed to the U.S.P.T.O. Counsel for Applicant agreed to prepare and file an Amendment/Response to Office Action including the recommendations of Examiner Novosad, the Applicant's remarks and an additional drawing. Counsel for Applicant further agreed to telephone Examiner Novosad when the Applicant's Amendment/Response to Office Action is ready to be mailed.

Respectfully submitted,



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